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10/766,697

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Robert Frederick

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12/06/2006

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EXAMINER

SHAH, AMEE A

ART UNIT

PAPER NUMBER

3625

DATE MAILED: 12/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/766,697

Applicant(s)

FREDERICK ET AL.

Examiner

Amea A. Shah

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 October 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-93 is/are pending in the application.
- 4a) Of the above claim(s) 1-15, 17-20, 22, 23, 25-27 and 29-84 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 16, 21, 24, 28 and 85-92 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 January 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date See Continuation Sheet.

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

Continuation of Attachment(s) 3). Information Disclosure Statement(s) (PTO/SB/08), Paper No(s)/Mail Date :8/3/04, 11/11/05, 2/28/06 & 6/9/06.

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DETAILED ACTION

Claims 1-93 are pending in this application. Claims 16, 21, 24, 28 and 85-93 are examined in this action.

Election/Restrictions

Applicant's election without traverse of invention II, claims 16-93, in the reply filed on October 12, 2006, is acknowledged.

Claims 1-15 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on October 12, 2006.

Applicant's election with traverse of species (6), claims 16, 21, 24, 28 and 85-93, in the reply filed on October 12, 2006, is acknowledged. The traversal is on the ground(s) that the Examiner allegedly has not established a serious burden and has not asserted either a separate classification, separate status in the art, or different field of search (Remarks, pages 16-17). This is not found persuasive because the species are distinct as separate embodiments (and described as such in the specification), the searches required for each species group are different, and the distinct species and the requirement for different searches for each species do impose a serious burden on the Examiner.

The requirement is still deemed proper and is therefore made FINAL.

Claims 17-20, 22, 23, 25-27 and 29-84 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to nonelected species, there being no allowable

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generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on October 12, 2006.

Drawings

The drawings are objected to as failing to comply with 37 CFR 1.84(p) because (1) they include the following reference character(s) not mentioned in the description: 351, 352, 354, 371, 372 and 374 (Figure 3); and (2) they contain handwritten text, some of which is illegible, that will not reproduce properly (Figures 2 and 4-7). Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

Applicant is reminded of the proper language and format for an abstract of the disclosure. The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words

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in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details. The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc. The abstract is objected to because it contains the implied phrase of the invention describes.

Claim Rejections - 35 U.S.C. § 101

35 U.S.C. §101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 87 is rejected under 35 U.S.C. §101 because the claimed invention is directed to non-statutory subject matter. Claim 87 is directed to a computer readable medium as a data transmission medium transmitting a generated data signal. Since signals are merely energy, they are nonstatutory natural phenomena. *See O'Reilly v. Morse*, 56 U.S. (15 How.) 62 at 112-14 (1853). Moreover, a signal encoded with functional descriptive material does not fall within any of the categories of patentable subject matter set forth in §101. It is not a process, because it is not a series of steps. The other three classes of §101, i.e. machine, and compositions of matter and manufactures, have traditionally required physical structure or material. Thus, a claim directed to a signal is directed to non-statutory subject matter under §101. Claim 87 will not further examined with respect to applicability of prior art.

Claim Rejections - 35 U.S.C. § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. §102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 16, 21, 24, 28, 85, 86 and 88-93 are rejected under 35 U.S.C. §102(e) as being anticipated by Hazzard et al., US 2005/0125389 A1 (hereafter referred to as “Hazzard”).

Referring to claim 16. Hazzard discloses a computer-implemented method for selling access to Web services to Web service consumers who are unrelated to Web service providers who provide those Web services (*see, e.g.,* Abstract), the method comprising:

- in response to registration requests from providers of Web services, registering Web services so as to make access to those Web services available for purchase by unrelated consumers of Web services, the registered Web services each having at least one associated use price (¶¶0021, 0022 and 0044 – note that the associated use prices are the payment terms);
- providing information about the available registered Web services to consumers of Web services (¶¶0022, 0027 and 0045);
- in response to each of multiple access requests from the consumers, performing a sale to a consumer for access to an indicated one of the registered Web services in exchange for an

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access fee from the consumer that is based on a use price associated with the indicated Web service (§§0045 and 0046);

- after each of at least some sales to a consumer for access to a registered Web service, providing to the consumer access to the registered Web service by invoking that Web service from the provider of the Web service on behalf of the consumer and by providing response information from the invoking to the consumer (§§0017, 0019, 0020, 0023, 0025, 0037 and 0045); and
- providing payment for each of the registered Web services to the provider of that Web service based on the access fees paid by the consumers for access to that Web service (§§0017 and 0046).

Referring to claim 21. Hazzard further discloses the method of claim 16 wherein the received access requests and the corresponding performed access sales are each for an access subscription for a consumer to a registered Web service (§§0037 and 0045 – note that the method authenticates the user in the subscriber database after receiving an access request).

Referring to claims 24 and 28. Hazzard further discloses the method of claim 21 wherein each access subscription provides a specified multiple number of times that access may be provided, including a single immediate access to a registered Web service such that the providing of the access to the consumer occurs in response to the access request that produced the access subscription (§0046).

Referring to claims 85 and 91. All of the limitations in apparatus claims 85 and 91 are closely parallel to the limitations of method claim 16, analyzed above and are rejected on the same bases.

Referring to claims 86 and 88. Hazzard further discloses the computer-readable medium of claim 85 wherein the computer-readable medium is memory of a computing system and the contents are instructions that when executed cause the computing system to perform the method (¶0018 – note that the method can be performed by any logic on hardware or software).

Referring to claim 89. Hazzard further discloses the computer-readable medium of claim 85 wherein the contents include one or more data structures comprising multiple entries that each correspond to one of the available Web services that has been registered by the third-party provider from whom the Web service is available, at least some of the entries including at least one use price and at least one use condition (¶¶0018-0020 – note the data structures include the directory database of the brokerage module).

Referring to claim 90. Hazzard further discloses the computer-readable medium of claim 85 wherein the contents include one or more data structures comprising multiple entries that each correspond to a subscription purchased by a consumer to one of the registered Web services, each of the entries including criteria indicating whether an attempted use of the subscription for an access of the registered Web service is valid (¶¶0023 and 0031 – note the data structures include the repository and the security modules).

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Referring to claims 92 and 93. All of the limitations in apparatus claims 92 and 93 are closely parallel to the limitations of apparatus claims 86 and 88, analyzed above and are rejected on the same bases.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

(1) Vadlamani, US 2002/0161676 A1, discloses a method and system for allowing a user to purchase a fixed quantity of access to web services (*see, e.g.*, pages 2-4).

(2) Pallister et al., US 2003/0195813 A1, cited by Applicant, discloses an automated auctioning system and method including registering web service providers, providing information on the providers to the customers, completing a sale by accepting a bid, and engaging the service by providing access (*see, e.g.*, Figs. 2-3 and pages 2-5).

(3) Moore et al., US 2002/0046255 A1, cited by Applicant, discloses a system and method for providing prepaid web services including offering and tracking access to web services and allowing the customer to purchase additional usage rights (*see, e.g.*, pages 3-5).

(4) Creamer et al., US 2005/0114437 A1, discloses a method for providing web services including registering web services with a service provider, receiving requests for the web service and allowing access to the web service (*see, e.g.*, Figs. 1-3 and pages 2-4).

(5) Osugi, JP 2001350943A, discloses a system and method for selling web services related to peripheral devices (*see Abstract*).

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(6) Windley, Phillip J., "Drafting the Next Phase of Web Services," InfoWorld, Dec. 1, 2003, vol. 25, iss. 47, pg. 47, discusses software for web services delivery contracts that include delivery preferences and service levels, and that automatically provisions accounts.

(7) Greiner, Lynn, "At Your Service," Computer Dealer News, May 16, 2003, vol. 19, iss. 8, pg. 16, discusses value added resellers of web services helping customers with web service implementation and applications.

(8) Dalton, Gregory, "Netscape Positions Itself as Business 'Intermediary'," InformationWeek, Jun. 8, 1998, iss. 685, pg. 34, discusses the Netscape Application Server as an intermediary for business-to-business selling of web services.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Amee A. Shah whose telephone number is 571-272-8116. The examiner can normally be reached on Mon.-Fri. 7:00 am - 3:30 pm.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A. Smith can be reached on 571-272-6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

AAS

December 4, 2006


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